

### **Remarks and Arguments**

Applicants have carefully considered the Office Action dated August 28, 2006 and the references cited therein. Applicants respectfully requests reexamination and reconsideration of the application.

Claim 1-35 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,965,912. Claim 1-35 have also been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending patent application Publication No. 2004/0177114A1 and copending patent application Publication No. 2006/0036681A1.

Applicant respectfully traverses these rejections on the grounds that the Examiner's analysis and reasoning in support of the rejection do not comply with the standards set forth in the M. P. E. P. 804(II)(B)(1) which specifically states:

Any obviousness- type double patenting rejection should make clear:

(A) The *differences* between the inventions defined by the conflicting claims -- a claim in the patent compared to the claimed in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the inventions defined in the claim in the issue is an obvious variation of the inventions defined in a claim in the patent.

*(emphasis added)*

In setting forth the grounds for the rejection, the Examiner has only alleged that the subject claims are broader, but in all instances has not identified the *differences* between the inventions claimed in the subject application and the cited patent or published pending applications. Accordingly, the Examiner has not made a limitation by limitation analysis, that identifies the differences between the limitations in each of the alleged conflicting claims, and, therefore, given the Applicant an opportunity to evaluate whether such differences are non-obvious under the *Graham vs. John Deere* standard.

Claims 1-35 have been rejected under 35 U.S.C. 102(b) as being anticipated by Small, U.S. Patent No. 5,513,117, hereafter Small '117. In setting forth

the rejection, the Examiner has cited specific sections of Small which are alleged to disclose the limitation of claims 1-35. After review of the portions of the Small reference provided, Applicants respectfully traverse the rejection as improper. Specifically, to anticipate a claim, a reference must teach every element of the claim (MPEP Section 2131). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 1, for example, the Examiner has failed to indicate where Small discloses the limitation of “generating a gift card having a gift card data reference thereon” and “comparing the greeting card data reference and the gift card data reference to determine a relationship therebetween” (claim 1, lines 11-13). Claims 34-35 recite similar language to claim 1. Applicants specifically request that the Examiner specifically identify where in the figures or disclosure of Small there is shown a data reference on both the greeting card and the gift card, or the process of comparing the greeting card data reference and the gift card data reference to determine a relationship therebetween. The examiner will note that in figures 10 and 11 of small, the calling card 174 and card 173 are the same entity and that item 175 is a UPC code while item 176 may be optional pricing information (Small, column 10, lines 12 – 19). In figure 10, and the greeting card and gift certificate are one in the same entity, as such there are not separate data references utilized to determine whether a relationship exists between the two because they are manufactured together. This is also true for the combined card 180 and get certificate 181 of the figure 11 in which a barcode 185 is printed all in the gift certificate 181. In the light of the foregoing, applicants respectfully assert that claims 1 is not anticipated by Small. Claims 2-11 include all the limitations of claim 1 and are likewise not anticipated by Small for at least the same reasons as claim 1, as well as for the merits of their own respective limitations For the same reasoning set forth with regard to claim 1, as well as for their own respective additional limitations which the examiner has not demonstrated or taught by

Small, claims 17 and 34-35, are not anticipated by Small (claim 17, lines 8-9; claim 24, lines 12-13; claim 34, lines 13-16; claim 35, lines 13-14).

Claims 28 is directed to a method in which a plurality of personalized greeting cards are printed in sequence and a plurality of gift cards are generated in sequence and further recites comparing the data reference of the greeting card having a position in sequence with the data reference a gift card having a similar position in sequence to determine if a relation exists there between. The Examiner has not shown where Small teaches, discloses or suggests such a process.

In light of the foregoing, applicants respectfully assert that none of the independent claims, as well as any of their respective the pending claims are anticipated by Small

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicants' attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,

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